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Examiner Behrend's request for a new second "first-restriction" is neither necessary nor proper nor legal for several reasons --especially when viewed in the light of the original application and the Office's previous demands on the Applicant.

THERE HAS ALREADY BEEN A RESTRICTION IN 1991 BY EXAMINER WASIL

4. Attention is directed to the fact that the original specification, claims and drawings of Serial no. 07/371,937 have already gone through a restriction by the Primary Examiner Daniel Wasil on September 16, 1991. This is relevant because this application is a continuation of Serial no. 07/371,937 which was restricted by Primary Examiner Daniel Wasil, delivered after his careful study of the original specification and claims. Mr. Wasil separated 07/371,937 into three inventions. For convenience of the Examiner, a copy of this relevant first restriction is attached (Exhibit B) and shown below.

Attention is now directed to exactly what Examiner Wasil stated in his very careful, and very erudite examination of Serial No 07/371,937. Mr. Wasil, in a signed communication, divided the applicant's claims into three groups, viz. "an apparatus and method for producing a vibration frequency of a cathode", "a system to monitor nuclear fusion reaction that comprises microwave radiation" and "apparatus and method for accelerating nuclear fusion reactions".

Serial No. 07/371937

Art Unit 224

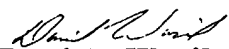
- 2 -

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-6, 19, drawn to apparatus and method for producing a vibrational frequency of a cathode, classified in Class 376, subclass 100.

II. Claim 7, drawn to a system to monitor nuclear fusion reactions that comprises microwave radiation, classified in Class 376, subclass 245.

III. Claims 8-9, 20-22, 25-26, drawn to apparatus and method for accelerating nuclear fusion reactions, classified in Class 376, subclass 100.


Daniel Wasil
Primary Examiner
Art Unit 224

In response to Primary Examiner Wasil's requirement that the applicant elect which invention he wished to continue prosecuting in the original application, Applicant elected the "apparatus and method for producing a vibration frequency of a cathode".

Applicant requests reconsideration, an examination of the actual record of this case, and a withdrawal of the second "first-restriction" requirement. Once again, the Applicant requests that the Office's future response be directed to the actual application, record, and previous response by Examiner Wasil.

**GIVEN THE RESTRICTION BY EXAMINER D. WASIL,
MR. BEHREND HAS NOT COMPLIED WITH 37 CFR 1.142**

5. The most important reason against this second "first-restriction" is that the Examiner appears to be coercing the Applicant into double patenting for reasons not presently clear. Given the restriction by Examiner D. Wasil, Mr. Behrend's attempt at re-restriction is neither necessary nor proper in light of 37 CFR 1.142. Simply put, Mr. Behrend has not explained why, given Examiner Wasil's previous restriction, the latest restriction can support separate patents which are independent [37 CFR §1.142, (MPEP §806.04 - §806.04(j))] and [37 CFR §1.142]/or [MPEP §806.05 - §806.05(i))] distinct.

"If two or more independent and distinct inventions are claimed in a single application, the examiner shall require...his claim shall be restricted" [Requirement for Restriction in the Code of Federal Regulations (37 CFR §1.142), underlined for emphasis]

Thus, Mr. Behrend's restriction is improper, capricious, and constructed to force the Applicant into double patenting.

Furthermore, Mr. Behrend's second "first-restriction" is improper. As the Court has found:

"Respondents' claims must be considered as a whole, it being inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis." [Diamond v. Diehr, 450 U.S. 175 (1981), 450 U.S. 175, No. 79-1112, 3/3/81]

Applicant requests reconsideration and withdrawal of the second "first-restriction" requirement.

**GIVEN THE RESTRICTION BY EXAMINER D. WASIL,
MR. BEHREND HAS NOT COMPLIED WITH MPEP §803**

6. Examiner Behrend's request for a second "first-restriction" is neither necessary nor proper in light of MPEP §803 because given Examiner Wasil's previous restriction, there cannot be any serious burden for the examiner to examine this case on the merits.

"803 - If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. ...There must be a serious burden on the examiner if restriction is required." [underlined for emphasis]

No burden has been shown because there has already been a restriction in 1992 by Examiner Wasil after careful examination of the record. Applicant requests reconsideration and withdrawal of the second "first-restriction" requirement.

**GIVEN THE RESTRICTION BY EXAMINER D. WASIL,
MR. BEHREND HAS NOT COMPLIED WITH THE GUIDELINES**

7. Examiner Behrend's request for restriction is neither necessary nor proper in light of the Office's Guidelines because given Examiner Wasil's previous restriction, the Examiners "must provide reasons and/or examples to support (his new) conclusions".

"GUIDELINES - Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the requirement in most cases. Where plural inventions are capable of being viewed as related in two ways, both applicable criteria for distinctness must be demonstrated to support a restriction requirement."

The Examiner has not shown that this second "first-restriction" requirement is necessary or proper, nor has the Examiner proved any reason to dispose of Mr. Wasil's reasoning. Applicant requests reconsideration and withdrawal of the second "first-restriction" requirement.

**GIVEN THE RESTRICTION BY EXAMINER D. WASIL,
MR. BEHREND IS COERCING DOUBLE PATENTING**

8. Examiner Behrend's request for restriction is neither necessary nor proper in light of MPEP §803.1 because given Examiner Wasil's previous restriction, the new Examiner's *de novo* and conflicting analysis appears to be improper and against the public interest.

"Since requirements for restriction under Title 35 U.S.C. 121 are discretionary with the Commissioner, it becomes very important that the practice under this section be carefully administered. Notwithstanding the fact that this section of the statute apparently protects

the applicant against the dangers that previously might have resulted from compliance with an improper requirement for restriction, it still remains important from the standpoint of the public interest that no requirements be made which might result in the issuance of two patents for the same invention. Therefore, to guard against this possibility, the primary examiner must personally review and sign all final requirements for restriction." [803.01, Review by Primary Examiner]

It is wrong for Mr. Behrens to (again) coerce a double patenting. Applicant requests reconsideration and withdrawal of the second "first-restriction" requirement.

**GIVEN THE RESTRICTION BY EXAMINER D. WASIL,
MR. BEHREND HAS NOT COMPLIED WITH MPEP §808**

9. Examiner Behrend's request for a second "first-restriction" is neither necessary nor proper in light of MPEP §808 because given Examiner Wasil's previous restriction, the new Examiner's conflicting analysis appears to be without foundation, and without "reasons" including "the reasons for insisting upon restriction".

"Every requirement to restrict has two aspects: (1) the reasons (as distinguished from the mere statement of conclusion) why the invention as claimed are either independent or distinct, and (2) the reasons for insisting upon restriction therebetween as set forth in the following sections." [MPEP 808, Reasons for Insisting Upon Restriction]

**GIVEN THE RECORD, THE NEW RESTRICTION
BY MR. BEHREND IS NON-COMPLIANT**

10. In addition to Mr. Behrend's latest restriction being non-compliant with Examiner Wasil, it is also inconsistent with the pleadings in the Office. The record has a series of Declarations based upon Mr. Wasil's previous decision. Applicant suggests that the Examiner read the record and make his statements corresponding to said record, including the past un rebutted Declarations [*In re Gazave*, 379 F.2d 973, 978, 154 USPQ 92, 96 (CCPA 1967); *In re Chilowsky*, 229 F.2d 457, 462, 108 USPQ 321, 325 (CCPA 1956); *In re Jolles*, 628 F.2d 1322, 206 USPQ 885 (CCPA 1980)].

**SUMMARY - REGARDING THE NEW
SECOND "FIRST-RESTRICTION" BY MR. BEHREND**

11. In summary, Applicant has pointed out numerous errors in Examiner Behrend's capricious action for a "second"-first restriction (supra). Applicant has also stated reasons why the restriction requirement should be withdrawn or modified with a substantive basis and explanation.

Simply put, given the previous restriction by examiner D. Wasil, Mr. Behrend's restriction by figures is improper. Examiner Behrend's request for this third "first-restriction" is capricious and suggests that he is not responding to the record or complying with the rules.

Applicant requests reconsideration and withdrawal of the second "first-restriction" requirement. Applicant hereby preserves the Right of Petition.

**MR. BEHREND'S ADDITIONAL RESTRICTION IS IMPROPER
AND WITHOUT BASIS**

12. Examiner Behrend has stated:

"3. Upon election of one of the species identified above as I-IV, applicant is further required under 35 USC 121 to elect a single specie of material which is to be loaded with a second material, for purposes of examination. This additional requirement is to facilitate examining due to the broad range of materials that are indicated as being suitable (e.g. see the bottom of page 3 of the specification)."

[Unsigned Communication From Harvey E. Behrend, 5/7/01]

The Examiner's request for election of single species of material is not proper for several reasons.

First, the Examiner's request for election of disclosed species is not proper at this time in light of the above-cited issues and matters because, pursuant to the Examiner, this response depends "*Upon election of one of the species identified above as I-IV*". Applicant necessarily is totally reliant upon the Examiner to reconsider first the Office's improper request for restriction (discussed in detail supra).

Second, the Examiner's request or election of a single species of material is not proper in light of MPEP §808.01(a) because there was disclosure of a relationship between many materials in the above-entitled application. This relationship overcomes the election requirement. There is no "patentable difference".

"When there is no disclosure of relationship between species, they are independent inventions and election of one invention following a requirement for restriction is mandatory even though the applicant disagrees with the examiner."

"Election of species should not be required if the species claimed are considered clearly unpatentable over each other." [MPEP §808.01(a)]

Third, the Examiner's request or election of a single species of material is not proper in light of MPEP 808.02 because the Examiner has not established any substantive reason for insisting upon his latest restriction.

"Where the related inventions as claimed are shown to be distinct...the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: (A) separate classification thereof; (B) a separate status in the art when they are classifiable together; (C) a different field of search"

"Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 USC §121 is never proper. If applicant optionally restricts, double patenting may be held." [MPEP §808.02]

Therefore, Applicant has stated reasons why the requirement should be withdrawn or modified. Applicant has pointed out errors in the Examiner's action. Therefore, Applicant requests reconsideration and explicitly traverses the requirement. If the Examiner refuses reconsideration, then if necessary, applicant elects "palladium".

Applicant hereby preserves the Right of Petition.

MR. BEHREND'S ADDITIONAL RESTRICTION IS IMPROPER AND WITHOUT BASIS

13. The Examiner has stated:

"4. Upon election of one of the species identified above as I-IV, applicant is further required under 35 USC 121 to elect a single specie of the manner of loading the second material, for purposes of examination. This additional requirement is to facilitate examining due to the diverse manners of loading that are indicated as being suitable (e.g. see the bottom of page 3 of the specification)."

[Unsigned Communication From Harvey E. Behrend, 5/7/01]

The Examiner's request for election of a manner of loading the second material is not proper for several reasons. Applicant requests reconsideration and withdrawal of the request for election of a manner of loading the second material for any of the following reasons.

First, the Examiner's request for election of a manner of loading the second material is not proper at this time in light of the above-cited issues and matters because, pursuant to the Examiner, this response depends "*Upon election of one of the species identified above as I-IV*". Applicant necessarily is totally reliant upon the Examiner to reconsider first the Office's improper request for restriction (discussed in detail supra).

Second, the Examiner's request or election of a manner of loading the second material may not be proper in light of MPEP §808.01(a). Depending on what the Examiner means, there may be no "patentable difference" between said different manner of loading the second material.

"Election of species should not be required if the species claimed are considered clearly unpatentable over each other." [MPEP §808.01(a)]

Third, the Examiner's request or election of disclosed species is not proper in light of 35 USC §121 because use of different methods of loading, as members of a group, may make the inventions related, and such related inventions are not patentably distinct. Therefore the Examiner's theory of a need for restriction is not proper under 35 USC §121.

Fourth, the Examiner's request or election of a manner of loading the second material is not proper in light of MPEP 808.02 because the Examiner has not established reasons for insisting upon his latest restriction.

"Where the related inventions as claimed are shown to be distinct...the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: (A) separate classification thereof; (B) a separate status in the art when they are classifiable together; (C) a different field of search"

**"Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 USC §121 is never proper. If applicant optionally restricts, double patenting may be held."
[MPEP §808.02]**

Therefore, Applicant has stated reasons why the requirement should be withdrawn or modified. Applicant has pointed out errors and the indefiniteness in the Examiner's action. Therefore, Applicant requests reconsideration and explicitly traverses the requirement. If the Examiner refuses reconsideration, then if necessary, applicant chooses loading the second material by electrical means. Applicant hereby preserves the Right of Petition.

MR. BEHREND'S FURTHER RESTRICTION IS INDEFINITE, IMPROPER, AND WITHOUT BASIS

14. The Examiner has stated:

"5. Upon election of one of the species identified above as I-IV, applicant is further required under 35 USC 121 to elect a single specie of monitoring configuration for purposes of examination. This additional requirement is to facilitate examining due to the diverse monitoring configurations indicated as being suitable (e.g. see the specification at the bottom of page 15 and the top of page 16)."

[Unsigned Communication From Harvey E. Behrend, 5/7/01]

The Examiner's request for election of a monitoring configuration for purposes of examination is not proper for several reasons, and therefore Applicant requests reconsideration and withdrawal of the request for election a monitoring configuration for purposes of examination for any of the following reasons.

First, the Examiner's request for election of a monitoring configuration for purposes of examination is not proper at this time in light of the above-cited issues and matters because, pursuant to the Examiner, this response depends "*Upon election of one of the species identified above as I-IV*". Applicant necessarily is totally reliant upon the Examiner to first reconsider the Office's improper request for restriction (discussed in detail supra).

Second, this description by the Examiner is indefinite. The Applicant has examined the location cited by the Examiner and does not understand the relevance. Applicant respectfully requests clarification.

Third, the Examiner's request or election of a monitoring configuration for purposes of examination may not be proper in light of MPEP §808.01(a). Depending on what the Examiner means, there may be no "patentable difference" between said different monitoring configuration for purposes of examination.

"Election of species should not be required if the species claimed are considered clearly unpatentable over each other." [MPEP §808.01(a)]

Fourth, the Examiner's request or election of disclosed species is not proper in light of 35 USC §121 because use of different monitoring configurations may make the inventions related, and such related inventions are not patentably distinct. Therefore the Examiner's theory of a need for restriction is not proper under 35 USC §121.

Fifth, the Examiner's request or election of a monitoring configuration for purposes of examination is not proper in light of MPEP 808.02 because the Examiner has not established reasons for insisting upon his latest restriction.

"Where the related inventions as claimed are shown to be distinct...the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: (A) separate classification thereof; (B) a separate status in the art when they are classifiable together; (C) a different field of search"

"Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 USC §121 is never proper. If applicant optionally restricts, double patenting may be held."
[MPEP §808.02]

Applicant has stated reasons why the requirement should be withdrawn or modified. Applicant has pointed out errors and the indefiniteness in the Examiner's action. Therefore, Applicant requests reconsideration and explicitly traverses the requirement. If the Examiner refuses reconsideration, then if necessary, applicant elects the monitoring configuration involving determination of frequency using electrical means. Applicant hereby preserves the Right of Petition.

APPLICANT FORMALLY REQUESTS SUGGESTIONS

15. Applicant requests constructive assistance and suggestions from the Examiner in drafting one or more acceptable claims [pursuant to MPEP 707.07(j)] and in making constructive suggestions [pursuant to MPEP 706.03(d)].

16. Applicant notes that the U.S. Supreme Court has ruled that any *pro se* litigant is entitled to less stringent standards [U.S. Rep volume 404, pages 520-521 (72)].

Respectfully,



Mitchell R. Swartz, ScD, MD, EE
16 Pembroke Rd., Weston, MA 02493

Certificate Of Mailing [37 CFR 1.8(a)]

May 10, 2001

To Whom it Does Concern:

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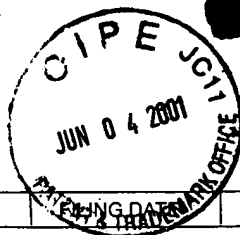
Thank you.

Sincerely,

5/31/2001
~~May 10, 2001~~



M.R. Swartz



UNITED STATES DEPARTMENT OF COMMERCE

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MV

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/750,480 12/28/00 SWARTZ

M

EXAMINER

PM82/0507
MITCHELL R. SWARTZ, SCD, EE, MD
16 PEMBROKE ROAD
WESTON MA 02493

BEHREND, H	
ART UNIT	PAPER NUMBER

3641

2

DATE MAILED:

05/07/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

EXHIBIT "A"
(cover+last page)

Art Unit: 3641

7. Any inquiry concerning this communication should be directed to Mr. Behrend at telephone number (703) 305-1831.

Behrend/cw
April 10, 2001

**HARVEY E. BEHREND
PRIMARY EXAMINER**

EXHIBIT "B" ⁻²⁻

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-6, 19, drawn to apparatus and method for producing a vibrational frequency of a cathode, classified in Class 376, subclass 100.

II. Claim 7, drawn to a system to monitor nuclear fusion reactions that comprises microwave radiation, classified in Class 376, subclass 245.

III. Claims 8-9, 20-22, 25-26, drawn to apparatus and method for accelerating nuclear fusion reactions, classified in Class 376, subclass 100.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as useable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately useable. In the instant case, invention I has separate utility such as producing a vibrational frequency without using microwave radiation. Invention II has separate utility such as monitoring without a vibrational frequency of a cathode. See MPEP 806.05(d).

Inventions I and III are related as subcombinations disclosed as useable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately useable. In the instant case, invention I has separate utility such as producing a vibrational frequency without accelerating nuclear fusion reactions. Invention III has separate utility such as accelerating nuclear fusion reactions without a vibrational frequency of a cathode. See MPEP 806.05(d).

Inventions II and III are related as subcombinations disclosed as useable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately useable. In the instant case, invention II has separate utility such as monitoring without accelerating nuclear fusion reactions. Invention III has separate utility such as accelerating nuclear fusion reactions without using microwave radiation. See MPEP 806.05(d).

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

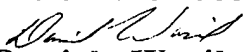
Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

The specification refers to numerous prior art documents. Copies of said prior art documents (including any English equivalent thereof) are requested for appropriate review by the Office. It is requested that form PTO-1449 be used.

An inquiry concerning this communication should be directed to Daniel Wasil at telephone number (703) 308-0442 or 308-0511.


Daniel Wasil
Primary Examiner
Art Unit 224